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EXAMINER

ARAQUE JR, GERARDO

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROD MANCISIDOR,
CHARLES R. ERICKSON,
AHMED GHEITH, and
WILLIAM W. CHAN

Appeal 2009-012664
Application 09/909,250
Technology Center 3600

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Rod Mancisidor et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the Examiner's final decision rejecting claims 1-8, 41-46, 51, and 66-82. We have jurisdiction over the appeal under 35 U.S.C. § 6(b) (2002).

We REVERSE.

Claim 1 is illustrative:

1. A method for recommending a product using a computer implemented expert system, the method comprising:

utilizing the expert system to determine problem domain information via interaction between a live human agent and a customer;

utilizing the expert system to determine need information of the customer via interaction between the live human agent and the customer, wherein the need information relates to telecommunications needs of the customer;

inputting the customer need information into the expert system, wherein the act of inputting the customer need information into the expert system is performed by the live human agent;

transforming the customer need information into a trait, the trait being characteristic of a telecommunications product of relevance to the customer, the telecommunications product of relevance being selected from a plurality of available telecommunications products;

calculating a rating of at least three telecommunications products within the plurality of available telecommunications products, wherein the act of calculating the ratings is performed by the expert system; and

presenting an output comprising a recommended solution, a compatible solution, and a not recommended solution, wherein each of said recommended solution, said compatible solution and said not recommended solution are alternative solutions selected from the plurality of available telecommunications products by the expert system, and wherein said output is generated by said expert system.

Appellants appeal the following rejection:

1. Claims 1-8, 41-46, 51, and 66-82 under 35 U.S.C. § 102(e) as anticipated by McCann (US 5,963,939; Oct. 5, 1999).

ISSUE

Does McCann describe, expressly or inherently, an output of alternative solutions; *e.g.*, “presenting an output comprising a recommended solution, a compatible solution, and a not recommended solution” (claim 1)?

FACTUAL FINDINGS

1. The Examiner found that McCann describes an output comprising a recommended solution, a compatible solution, and a not recommended solution, citing to col. 3, ll. 18-22 and col. 4, ll. 24-33. Answer 4.

2. Col. 3, ll. 18-22 and col. 4, ll. 24-33 of McCann generally describe a system for suggesting solutions.

3. Fig. 51 of McCann shows a system providing a single solution.

ANALYSIS

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

With respect to the method claims 1-8 and 66-82, the Appellants argue that McCann does not describe “presenting an output comprising a recommended solution, a compatible solution, and a not recommended

solution” and “producing at least three product solutions ... [comprising] a recommended solution, a compatible solution, and a not recommended solution”, as set forth in independent claims 1 and 68, respectively. App. Br. 17. We agree.

The Examiner found that McCann describes an output comprising a recommended solution, a compatible solution, and a not recommended solution. FF 1. We do not see there an express or inherent description of such an output. The passages in McCann that the Examiner cites to generally describe a system for suggesting solutions but do not expressly mention “a recommended solution, a compatible solution, and a not recommended solution.” FF 2. While it is possible that the solutions the McCann system would suggest might include “a recommended solution, a compatible solution, and a not recommended solution,” it does not necessarily flow from practicing McCann’s system. This can be seen in Fig. 51 which, as the Appellants (App. Br. 19) point out, appears to show only a single solution. FF 3. Accordingly, an output comprising a recommended solution, a compatible solution, and a not recommended solution is also not inherently disclosed. “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Hansgird v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). We reach the same conclusion with respect to method claims 68-82, the claimed subject matter of which calls for “producing at least three product solutions ... a recommended solution, a compatible solution, and a not recommended solution.”

With respect to the system claims 41-45, the claimed subject matter calls for an “expert system [which] generates output comprising a recommended telecommunications solution and a compatible telecommunications solution” (claim 41). With respect to the “software instructions stored on a media” claims 46 and 51, the claimed subject matter calls for a set of instructions executed by processing circuitry that “presents an output to the live human agent, said output comprising a recommended solution, and a not recommended solution” and “generates output comprising a recommended solution and a compatible solution,” respectively. Accordingly, these claims call for outputs with more than one solution. As evidence that McCann describes an output comprising more than one solution, the Examiner points to col. 3, ll. 30-46; col. 4, ll. 24-30; and, Figs. 50 and 51 in addition to col. 3, ll. 18-22 and col. 4, ll. 24-33. Answer 8, 10, and 13. However, col. 3, ll. 30-46; col. 4, ll. 24-30; and, Figs. 50 and 51 describe only that a search of possible solutions can be narrowed. However, an output of only a single solution is expressly described. See Fig. 51. Outputs comprising a “recommended telecommunications solution and a compatible telecommunications solution” (claim 41); “recommended solution and a not recommended solution” (claim 46); and, “a recommended solution and a compatible solution” (claim 51) are not expressly or inherently described.

DECISION

We reverse the Examiner’s rejection of claims 1-8, 41-46, 51, and 66-82 under 35 U.S.C. § 102(e).

Appeal 2009-012664
Application 09/909,250

ORDER
REVERSED

mev

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